

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 15, and 31-53 are currently pending in this application. Claims 15 and 42 are independent. The remaining claims depend, directly or indirectly, from claims 15 and 42.

Claim Amendments

Independent claims 15 and 42 have been amended by this reply to recite that a list of menu items corresponding to services is displayed to a user, where the subsidiary menu is displayed together with only the menu items corresponding to the service chosen by the user. Further, amended independent claim 15 now recites “wherein interference with the program is minimal.” Support for these amendments may be found, for example, on page 19, lines 11-14 of the Specification. Thus, no new subject matter is added by way of these amendments.

Rejections under 35 U.S.C. § 103

Claims 15 and 31-53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,772,433 (“LaJoie”) in view of U.S. Patent No. 5,828,420 (“Marshall”). Independent claims 15 and 42 have been amended by this reply. To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

The claimed invention recites a method of providing a user with options for accessing at least one of multiple received channels. The received channels include at least one channel and a service channel corresponding to a digital television system. The method of the present

invention provides for a service menu shown on a display to be generated. The display is superimposed over a program transmitted on one of the received channels. The service menu includes a list of several menu items corresponding to services available to a user. Using the list of menu items, a user selects a particular menu item corresponding to a desired service, and a subsequent submenu is displayed for the user. The submenu is displayed together with only the selected menu item (*See Specification, Figure 5*). Thus, the way information is presented to the user in the claimed invention allows for easier navigation for the user. Particularly, the claimed invention “removes” everything around the chosen menu item and displays the submenu next to the chosen menu item, allowing the user to immediately see the chosen menu items and the new options corresponding to the chosen menu item is easily found on the screen.

Further, by displaying only the chosen option together with the submenu, the *interference with the underlying program is kept to a minimum*, so that a user can still see the underlying program running while navigating through the list of menu items and the submenu of a menu item chosen. Accordingly, claim 15 has been amended to recite “wherein interference with the program is minimal.”

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner has admitted that LaJoie fails to disclose or suggest superimposing menus and submenus over a program transmitted on one of the received channels. Because LaJoie does not superimpose menus, but rather, abruptly changes the screen and completely covers the underlying program when a user chooses a menu option, LaJoie also cannot possibly disclose displaying only the chosen menu item associated with a service together with the submenu for that chosen menu item. Said another way, because LaJoie does not superimpose menus over the underlying program, there is no need for LaJoie to minimize what is displayed to the user, and thus, does not contemplate displaying only the selected menu item together with the submenu associated with the selected menu item.

In fact, as seen in Figures 27 and 28 of LaJoie, the user selects an option in the interactive program guide (IPG) (*e.g.*, the film Bridges of Madison County (75) in Figure 28 of LaJoie), which bring up an event barker related to the film and through which several more sub-options are presented to the user. The event barker does not display *only* the selected menu item of a service with the submenu. As shown in Figure 28 of LaJoie, when “Bridges of Madison County” is selected, the next screen displayed (*i.e.*, 544 in Figure 28) shows a description of the movie, running time, etc., and **not** only the selected menu item with a submenu. Comparing Figure 5 of the claimed invention and Figure 28 of LaJoie clearly enables one skilled in the art to distinguish the manner in which menus/submenus are displayed in the claimed invention and in the LaJoie. Further, because the display screen for the menu and sub-menus in LaJoie covers the entire program, it is not possible for LaJoie to contemplate minimal interference with the underlying program, as required by the amended independent claims.

Further, Marshall fails to supply that which LaJoie lacks. Although Marshall discloses superimposing menus over an underlying program, Marshall fails to disclose or suggest

displaying only a selected menu item corresponding to a service, together with a submenu associated with the selected menu item. In fact, it is clear from Figures 3-4 of Marshall, which show the interactive program guide menu displayed to a user, that keeping the interference with the underlying program to a minimum is not something Marshall contemplates. The IPG menu displayed in Marshall almost covers the entire underlying program, whereas the manner in which menus are displayed in the claimed invention (as shown in Figure 5 of the present invention) definitely keeps interference with the underlying program at a minimum, so that the underlying program is still viewable by a user navigating through services and submenus.

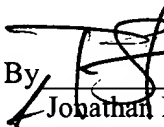
Thus, in view of the above, it is clear that neither LaJoie nor Marshall, whether considered separately or in combination, render amended independent claim 15 as obvious. Dependent claims 31-41 are allowable for at least the same reasons. Further, independent claim 42 has been amended to include similar allowable subject matter and is allowable for at least the same reasons. Dependent claims 43-53 are also allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345.019001).

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Respectfully submitted,

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